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650 Town Center Drive  
Suite 1600  
Costa Mesa, California 92626-7130  
(714) 540-8700

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TO:	Examiner T. Duong Group Art Unit 2143		
FROM:	Michael K. O'Neill		
RE:	U.S. Application 09/661,030 Atty. Docket No. 03630-000284		
FAX NO.:	(703) 872-9306		
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**MESSAGE**

Attached is a Response And Request For New Office Action in response to the Office Action dated September 13, 2004.

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on:

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(Name of Attorney for Applicant)

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OCT 13 2004

03630.000284.

PATENT APPLICATION

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
MARTIN PAGE, et al. ) Examiner: T. Duong  
Application No.: 09/661,030 ) Group Art Unit: 2143  
Filed: September 13, 2000 )  
For: DIRECTORY-ENABLED )  
DEVICE MANAGEMENT : October 13, 2004

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE  
AND  
REQUEST FOR NEW OFFICE ACTION

Sir:

This is a response to the Office Action dated September 13, 2004.

A new Office Action is respectfully requested, to correct legal and procedural errors in the Office Action's treatment of most of the dependent claims. It is further requested to re-start the period for response commencing with the date on which a new Office Action is mailed.

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October 13, 2004  
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Michael K. O'Neill, Reg. No. 32,622  
(Name of Attorney for Applicant)

Signature

October 13, 2004  
Date of Signature

The error complained of is the failure of the Office Action to consider the subject matter of each of the dependent claims as a whole. Rather, the Office Action entered art-based rejections of dependent claims based strictly on their dependency from a rejected independent claim, and without considering the subject matter added by the dependent claim itself. Specifically, paragraph 5 of the Office Action (on page 8) indicates that all of the dependent claims "are rejected at least by [virtue] of their dependency on the independent claims...". Of course, it is legal error to enter an art-based rejection of dependent claims based strictly on their dependency from an independent claim. This is borne out by MPEP § 608.01(n) which specifically reminds the Examiners to consider dependent claims as a whole, including both the subject matter of the independent claim and the dependent claim itself:

"The Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim" (MPEP page 600-80).

Paragraph 5 of the Office Action actually indicted that the dependent claims were "rejected at least by [virtue] of their dependency on the independent claims *and by other reasons set forth in the previous office action*". (Emphasis added.) However, for most of the dependent claims, the previous Office Action (as well as the instant Office Action) included virtually identical language which clearly signifies that the subject matter of the dependent claims was not considered as a whole. For example, paragraphs 12, 13 and 14 at page 12 of the instant Office Action are reproduced below:

"12. With regard to claims 9, 35, 61 and 87, they include features or limitations as in claim 1. Thus, claims 9, 35, 61 and 87 are also rejected under the same [rationale] as cited in the rejection of the claim 1 (see claim 1 rejection as detailed above).

"13. With regard to claims 11-13, 37-39, 63-65 and 89-91, they include features or limitations as in claim 1. Thus, claims 10-14, 23-25, 36-41, 49-51, 62-66, 75-77, 88-92 and 101-103 [sic, what claims were intended?] are also rejected under the same [rationale] as cited in the rejection of the claim 1 (see claim 1 rejection as detailed above).

"14. With regard to claims 15-22, 41-48, 67-74 and 93-100, they include features or limitations as in claim 1. Thus, claims 15-22, 41-48, 67-74 and 93-100 are also rejected under the same [rationale] as cited in the rejection of the claim 1 (see claim 1 rejection as detailed above)."

It is therefore clear that the rejection of most of the dependent claims is legally flawed since the rejection failed to consider the claims as a whole. Thus, Applicants are left without such information as may be useful in judging the propriety of continuing prosecution of their application. See 35 U.S.C. § 132(a).

A new Office Action is therefore warranted, and it is therefore respectfully requested that the date for response be re-started commencing with the date on which the new Office Action is mailed. It is further respectfully submitted that the new Office Action cannot enter a rejection marked "final" if the new Office Action enters a new rejection of any of the dependent claims.

This matter was brought to the Patent Office's attention in two separate telephone interviews on October 12, 2004: a first with Examiner Duong, and a second with Supervisory Examiner Vaughn. Neither telephone interview resulted in a

commitment from the Patent Office to issue a corrected Office Action, and it was therefore deemed prudent to file this Request.

Applicants' undersigned attorney may be reached in our Costa Mesa, CA office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



Attorney for Applicants  
Michael K. O'Neill  
Registration No. 32,622

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-2200  
Facsimile: (212) 218-2200

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